

### **STATUS OF CLAIMS**

Claims 1-15 are pending.

Claims 1-15 stand rejected by the Examiner.

Claims 1, 7 and 10 has been amended, herein.

Claims 16 and 17 have been cancelled, without prejudice, herein.

### **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Objections to the Specification**

The Specification has been objected to due to informalities. Applicant has amended the Specification to remove these informalities.

### **Objections to the Drawings**

The Drawings have been objected to for failing to comply with 37 CFR 1.84(p)(5) for not including a reference sign mentioned in the description. Applicant submits the Specification, as amended, removes the reference sign absent in the drawings, and allows the drawings as originally filed to comply with 37 CFR 1.84(p)(5).

### **Claims Restriction**

Applicant has cancelled claims 16 and 17 without prejudice, although Applicant further reserves the right to prosecute claims 16 and 17 in any other subsequent application. Applicant further notes that the present Office Action mistakenly asserts that the election made from the restriction requirement of the prior Office Action dated March 4, 2005, was made *without* traverse.

However, Applicant specifically stated in Applicant's previous response dated March 18, 2005 that the election was made with traverse. (Applicant's Response of March 18, 2005, at page 2, last paragraph)

**Claim Rejections Pursuant to 35 U.S.C. 112, Second Paragraph**

Claims 7-15 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out distinctly claim the subject matter which the Applicant regards as the invention.

35 U.S.C. 112, second paragraph, states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The present Office Action rejects claims 7 and 10 for lacking antecedent basis, specifically referencing the portion of the claims which states "said second surface". Applicant has amended claims 7 and 10 to more distinctly point out and claim the present invention. Applicant respectfully submits claims 7 and 10, as amended, have proper antecedent basis and satisfy the requirements of 35 U.S.C. § 112. Applicant further submits claims 8, 9 and 11-15 also satisfy the requirements of 35 U.S.C. § 112, as these claims ultimately depend from either of claims 7 or 10.

**Claim Rejections Pursuant to 35 U.S.C. §102**

Claims 1-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by Gartner (U.S. Patent No. 5,284,363). Claims 1-14 have been rejected under 35 U.S.C. §102(e) as being anticipated by Sellars (U.S. Patent Application Publication No. US 2003/0027700A1). Claims 1-8 have been rejected under 35 U.S.C. §102(a) as being anticipated by Bernier (U.S. Patent No. 6,637,775). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §102 recites, in part:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent ...

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language...

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).*

Applicant respectfully submits that the cited references of record do not teach each of the limitations of independent claim 1, as amended. Specifically, neither Gartner, Sellars nor Bernier teach a labeling apparatus having at least one predefined tearing region within the first and second substantially planar members. The labels of Garner, Sellars and Bernier are each designed for labeling containers not intended for destruction. In fact, accessing a product within these containers is done through a predefined opening, which is separate and distinct from the portion of the container that is labeled. Thus, because access to these containers is designed away from the labels, these labels do not contain predefined tearing regions for accession to the product.

However, Applicant submits the present invention is designed for labeling a roll of product, and not a product held within a distinct container. Thus, the labeling apparatus must be suitable for at least partial tearing to access the product within. Exemplary support for this feature of the labeling apparatus may be found in an embodiment described in the Specification, where the substantially planar members “may... include perforations corresponding to positioning of apparatus 100 with respect to product 20, for facilitating partial destruction of member 150 to access product 20.” (Specification at page 6, 2<sup>nd</sup> full paragraph)

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. 102(a, b and e) rejections of claim 1, as each of Gartner, Sellars and Bernier fails to teach the invention recited in claim 1. Further, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. 102(a, b and e) rejections of claims 2-14, as each of these claims ultimately depend from a patentably distinct independent base claim 1.

#### **Rejections based on 35 U.S.C. § 103 (a)**

Claims 9-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner (U.S. Patent No. 5,284,363), as well as over Bernier (U.S. Patent No. 6,637,775). Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Sellars (U.S. Patent Application Publication No. US 2003/0027700A1). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have

been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For at least the reasons stated above, the cited references, either separately or in any combination, do not teach or suggest each of the limitations of claim 1. Specifically, as previously explained, neither Gartner, Sellars nor Bernier teach a labeling apparatus having at least one predefined tearing region within the first and second substantially planar members. In addition, in the complete absence of such limitations, there is no suggestion or motivation to modify any single reference or to combine these reference teachings. Accordingly, Applicant submits at least claim 1 is patentably distinguishable over the art of record. Applicant further submits that claims 2-15 are similarly distinguishable over the art of record, at least by virtue of their ultimate dependency from a patentably distinct base claim 1.

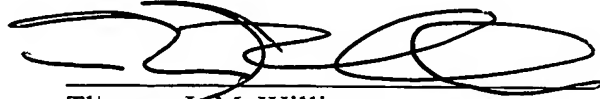
## **CONCLUSION**

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and respectfully submits the present case is in condition for allowance,

early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

Date: September 14, 2005

A handwritten signature in black ink, appearing to read 'Thomas J. McWilliams', written over a horizontal line.

Thomas J. McWilliams

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